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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,342	03/11/2004	David Charles Lyons	77012-325539	6247
58506 7590 06/27/2007 FAEGRE & BENSON, LLP PATENT DOCKETING 90 SOUTH SEVENTH STREET 2200 WELLS FARGO CENTER MINNEAPOLIS, MN 55402			EXAMINER PAINTER, BRANON C	
			ART UNIT 3609	PAPER NUMBER
			MAIL DATE 06/27/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/799,342	LYONS ET AL.	
	Examiner	Art Unit	
	Branon C. Painter	3609	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>09/02/05 & 10/25/05</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statements (IDS) submitted on 09/02/2005 and 10/25/2005 were filed after the mailing date of the non-provisional application on 03/11/2004. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Drawings

2. The drawings are objected to under 37 CFR 1.83(a) because they fail to show "inner opening 32" as described in the specification. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the

remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Objections

3. Claim 7 is objected to because of the following informalities: "adjacent tot eh fireplace." For the purpose of this examination, the examiner presumes that "tot eh" should read "to the." Appropriate correction is required.
4. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1, which claim 13 depends from, already requires the first and second members to be oriented generally horizontally.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claim 28 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "coupling the first and second overlap members to the second ends of respective first and second side members" is vague and indefinite because it depends from claim 27, which calls for the overlap members to be coupled to the first ends of the side members. It is impossible for the overlap members to be connected to both ends of the side members. To the examiner's best understanding, and for the purpose of this examination, the examiner presumes that claim 28 was meant to depend from claim 26, not claim 27.

Claim Rejections - 35 USC § 102

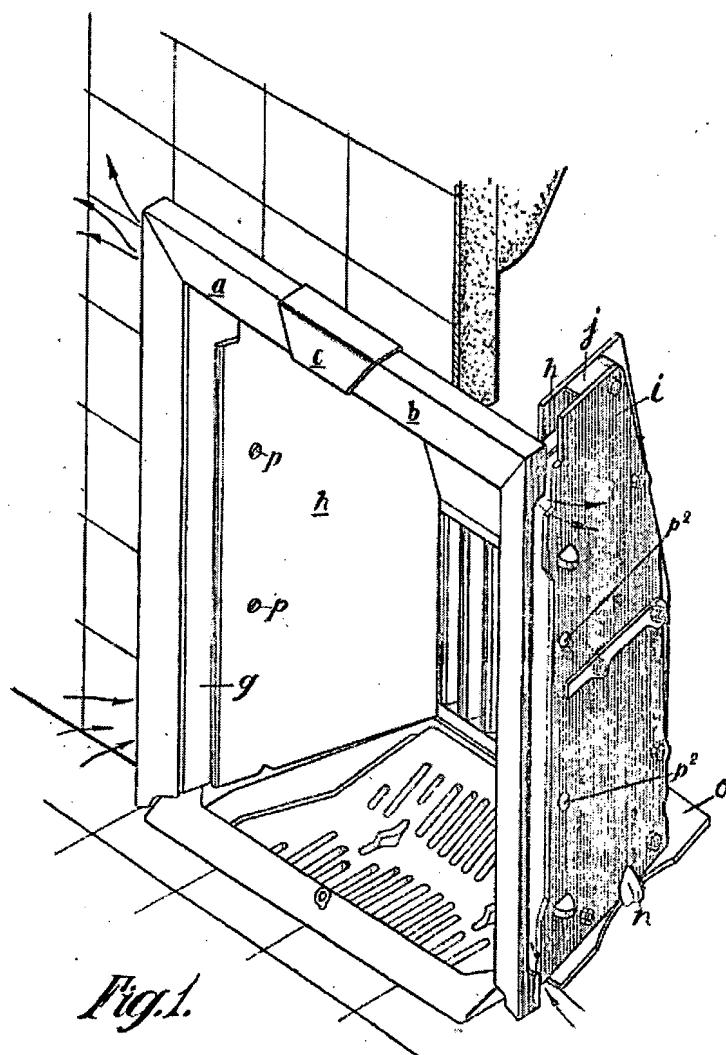
7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1-3, 9, 10, 13, 15-17, 24 and 25 are rejected under 35 U.S.C. 102(b) as being anticipated by Baxendale (G.B. Patent No. 852,169).
9. Regarding claim 1, Baxendale discloses a fireplace surround having all of the applicant's claimed structure, including:
 - a. "a first member having first and second ends..." (horizontal portion of "front member" a, Fig. 1).

- b. "...a second member having first and second ends, the first and second members being oriented generally horizontally with the first ends facing each other..." (horizontal portion of "front member" b, Fig. 1).
- c. "...a distance between the second ends of the first and second members defining a width of the surround..." (Fig. 1).
- d. "...wherein the first and second members are movable relative to each other to vary the width of the surround." ("two front members...interconnected at a midpoint in the width of the top of the fireplace by means which permit of adjustment of the width of such frame to suit the width of the fire opening," page 1, lines 19-24).



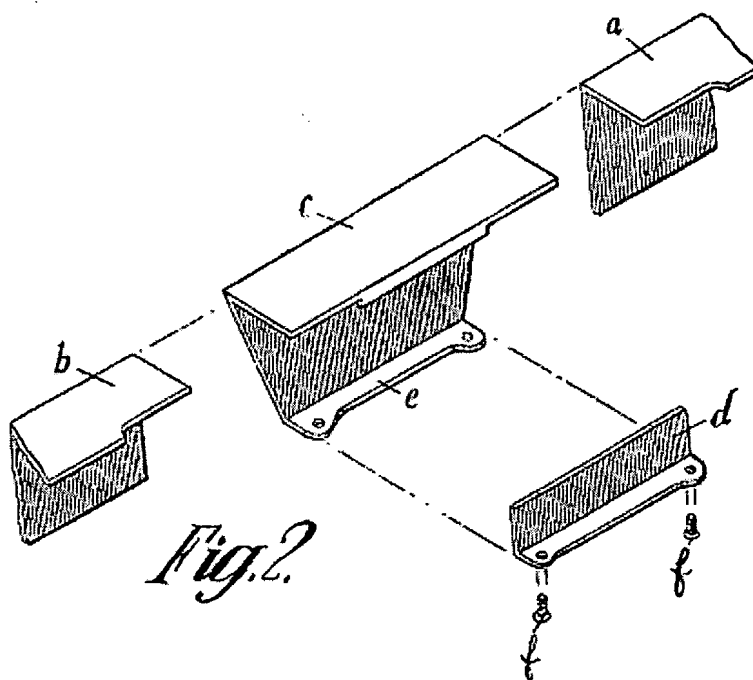
Reproduced from G.B. Patent No. 852,169

10. Regarding claim 2, Baxendale discloses a first overlap member configured to cover a spacing between the first ends of the first and second members ("member" c, Fig. 1).
11. Regarding claim 3, Baxendale discloses maximum spacing between the first ends of the first and second members no greater than the width of the overlap member (Fig. 1).

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12. Regarding claim 9, Baxendale discloses a keystone-shaped first overlap member ("member" c, Fig. 1).

13. Regarding claim 10, Baxendale discloses a first overlap member with a front decorative surface and a rear surface including a track structure ("member" c, Fig. 2).



Reproduced from G.B. Patent No. 852,169

14. Regarding claim 13, Baxendale discloses first and second members oriented horizontally (horizontal portions of "front members" a and b, Fig. 1).

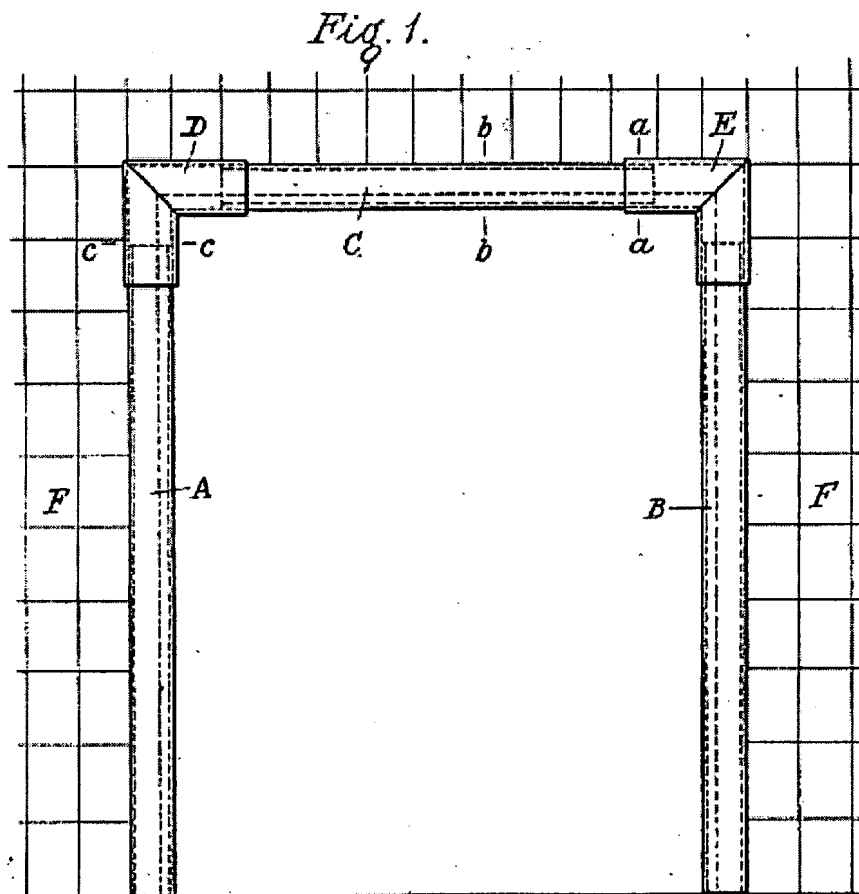
15. Regarding claim 15, Baxendale discloses a fireplace surround having all of the applicant's claimed structure, including:

- a. "first and second top members arranged end to end in a generally horizontal orientation..." (horizontal portions of "front members" a and b, Fig. 1).

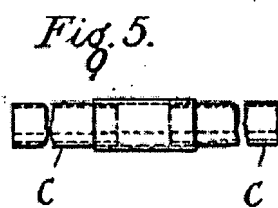
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- b. "...defining a width of the surround..." (Fig. 1):
 - c. "...wherein the first and second top members are movable relative to each other to alter the width of the surround." ("two front members...interconnected at a midpoint in the width of the top of the fireplace by means which permit of adjustment of the width of such frame to suit the width of the fire opening," page 1, lines 19-24).
16. Regarding claim 16, Baxendale discloses first and second top members, each including first ends that face one another, where movement of the first and second top members adjusts a spacing between the first ends (horizontal portions of "front members" a and b, Fig. 1; the ends of a and b facing each other and hidden by member c are the first ends).
17. Regarding claim 17, Baxendale discloses a first overlap member configured to overlap the first ends of the first and second top members ("member" c, Fig. 1).
18. Regarding claims 24 and 25, the structure of the apparatus renders the claimed method steps inherent since the claimed method steps would inherently be performed when assembling the surround as disclosed by Baxendale.
19. Claims 1, 4-6, 11, 12, 14, 20, 21, 23, 26, and 28-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Pollock (G.B. Patent No. 279,987).
20. Regarding claim 1, Pollock discloses a fireplace surround having all of the applicant's claimed structure, including:

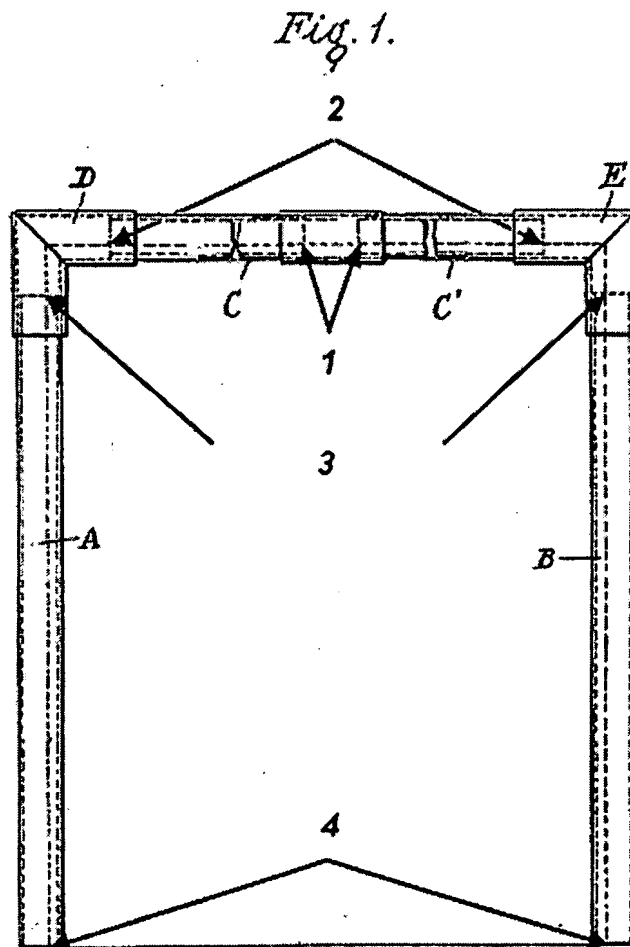
- a. "a first member having first and second ends..." ("metal length" C, amended Fig. 1). The examiner has amended Fig. 1, incorporating the plurality of pieces shown in Fig. 5 (referred to as "amended Fig. 1").
- b. "...a second member having first and second ends, the first and second members being oriented generally horizontally with the first ends facing each other..." ("metal length" C', Fig. 5, amended Fig. 1). Pollock states "I may make the lengths A, B, C in several pieces for each side or the top and join them together by fitting the meeting ends in covering pieces of thin metal which grip and conceal the joint in such a way that the lengths may be moved towards or away from each other in the covering pieces and so further enlarge or reduce the size of the frame, as will be understood from Figure 5" (page 2, lines 62-71).
- c. "...a distance between the second ends of the first and second members defining a width of the surround..." (Fig. 1, amended Fig. 1).
- d. "...wherein the first and second members are movable relative to each other to vary the width of the surround." ("metal lengths A, B, C and corner pieces D, E being so shaped or constructed that the ends of the lengths A, B, C can slide into the corner pieces D, E, the corner pieces D, E being of sufficient length to allow of the lengths A, B, C to be moved in the corner pieces D, E to suit the size of the surround F," page 2, lines 30-38).



Reproduced from G.B. Patent No. 279,987



Reproduced from G.B. Patent No. 279,987



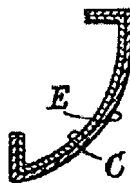
Reproduced from G.B. Patent No. 279,987 (Amended by examiner to highlight details)

21. Regarding claim 4, Pollock discloses first and second side members extending generally vertically from the second ends of respective first and second horizontal members ("metal lengths" A and B, Fig. 1).
22. Regarding claim 5, Pollock discloses first and second side members each including first and second ends of a length, the second ends of the first and second side members being coupled to the second end of respective first and second members, the length of the first and second side members defining a portion of a height in the surround (second ends 2 and 3, amended Fig. 1). The examiner notes that no

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claims depend from claim 5, and no other claims require that the second ends be coupled, so the labels 2 and 3 may represent different sides in response to future claims without being contradictory.

23. Regarding claim 6, Pollock discloses second and third overlap members coupled to respective first and second side members, where relative movement between the two allows for adjustment in height ("metal lengths" A and B, Fig. 1).
24. Regarding claim 11, Pollock discloses second and third overlap members with a front decorative surface and a rear surface including a track structure ("corner piece" E, Fig. 2).

Fig. 2.

Reproduced from G.B. Patent No. 279,987

25. Regarding claim 12, Pollock discloses second and third overlap members coupled to the first ends of respective side members ("corner pieces" D and E coupled to first end 3, amended Fig. 1).
26. Regarding claim 14, Pollock discloses overlap members coupled to the second ends of the first and second members, and to the first ends of the side members ("corner pieces" D and E coupled to second ends 2 and first ends 3, amended Fig. 1).

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27. Regarding claims 20, 21, 23, 26, and 28, the structure of the apparatus renders the claimed method steps inherent since the claimed method steps would inherently be performed when assembling the surround as disclosed by Pollock. This particular combination (with a single top member) can be found in Fig. 1.

28. Regarding claim 29, Pollock discloses a fireplace surround having all of the applicant's claimed structure, including:

- a. "a top member oriented horizontally..." ("metal length" C, Fig. 1).
- b. "...first and second side members oriented vertically..." ("metal lengths" A and B, Fig. 1).
- c. "...wherein vertical movement of the first and second side members relative to the top member adjusts the size of the surround." (metal lengths A, B, C and corner pieces D, E being so shaped or constructed that the ends of the lengths A, B, C can slide into the corner pieces D, E, the corner pieces D, E being of sufficient length to allow of the lengths A, B, C to be moved in the corner pieces D, E to suit the size of the surround F," page 2, lines 30-38).

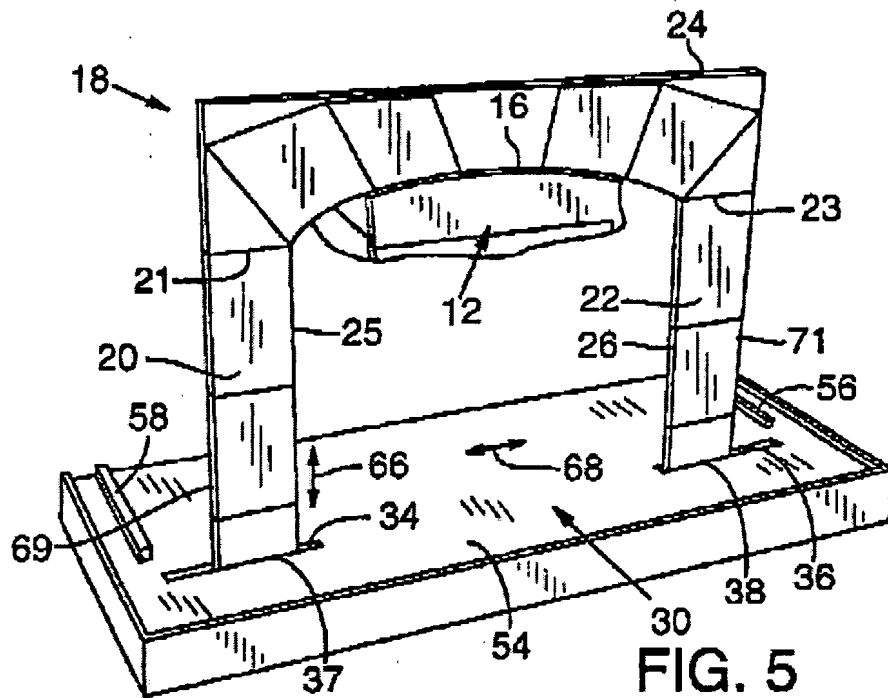
29. Regarding claim 30, Pollock discloses a surround where relative movement between the top member and the first and second side members adjust the height of the surround (metal lengths A, B, C and corner pieces D, E being so shaped or constructed that the ends of the lengths A, B, C can slide into the corner pieces D, E, the corner pieces D, E being of sufficient length to allow of the lengths A, B, C to be moved in the corner pieces D, E to suit the size of the surround F," page 2, lines 30-38).

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30. Regarding claim 31, Pollock discloses a surround where relative movement between the top member and the first and second side members adjusts the width of the surround (metal lengths A, B, C and corner pieces D, E being so shaped or constructed that the ends of the lengths A, B, C can slide into the corner pieces D, E, the corner pieces D, E being of sufficient length to allow of the lengths A, B, C to be moved in the corner pieces D, E to suit the size of the surround F," page 2, lines 30-38).
31. Regarding claim 32, Pollock discloses first and second overlap members configured to cover an intersecting point between the top member and respective first and second side members ("corner pieces" D and E, Fig. 1).
32. Claims 18, 19, 26, and 27 are rejected under 35 U.S.C. 102(a) as being anticipated by Richmond et al. (U.S. Pub. No. 2003/0140570).
33. Regarding claim 18, Richmond et al. discloses a fireplace surround having all of the applicant's claimed structure, including:
- a. "first and second side members extending generally vertically on opposing sides of a combustion chamber enclosure or fireplace..." ("surround leg portions" 20 and 22, Fig. 5).
 - b. "...first and second overlap members configured to be coupled to respective first and second side members..." ("base" 30, Fig. 5). Richmond et al. states "the base may be of a plural piece construction" (paragraph 11, line 2). In this case, the base viewed from the front (as in Fig. 5) could have a left and

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- right portion, with each portion corresponding to a side member, and fully containing the slot for engaging the corresponding side member.
- c. "...wherein relative movement between the first and second side members are respective first and second overlap member adjusts a height of the surround." ("movement upwardly and downwardly" 66, Fig. 5).



Reproduced from U.S. Pub. No. 2003/0140570

34. Regarding claim 19, Richmond et al. discloses first and second side members with first ends oriented generally downward facing ("lower end portions" 37 and 38, Fig. 5), and the first and second overlap members are configured to be coupled to the first end of respective first and second side members ("slots" 34 and 36 receiving first ends "lower end portions" 37 and 38, Fig. 5).

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35. Regarding claims 26 and 27, the structure of the apparatus renders the claimed method steps inherent since the claimed method steps would inherently be performed when assembling the surround as disclosed by Richmond et al.

Claim Rejections - 35 USC § 103

36. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

37. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

38. Claims 7, 8, 22, and 33 rejected under 35 U.S.C. 103(a) as being unpatentable over Pollock (G.B. Patent No. 279,987) in view of Wright et al. (U.S. Patent No. 4,254,596).

39. Regarding claims 1, 7, and 8:

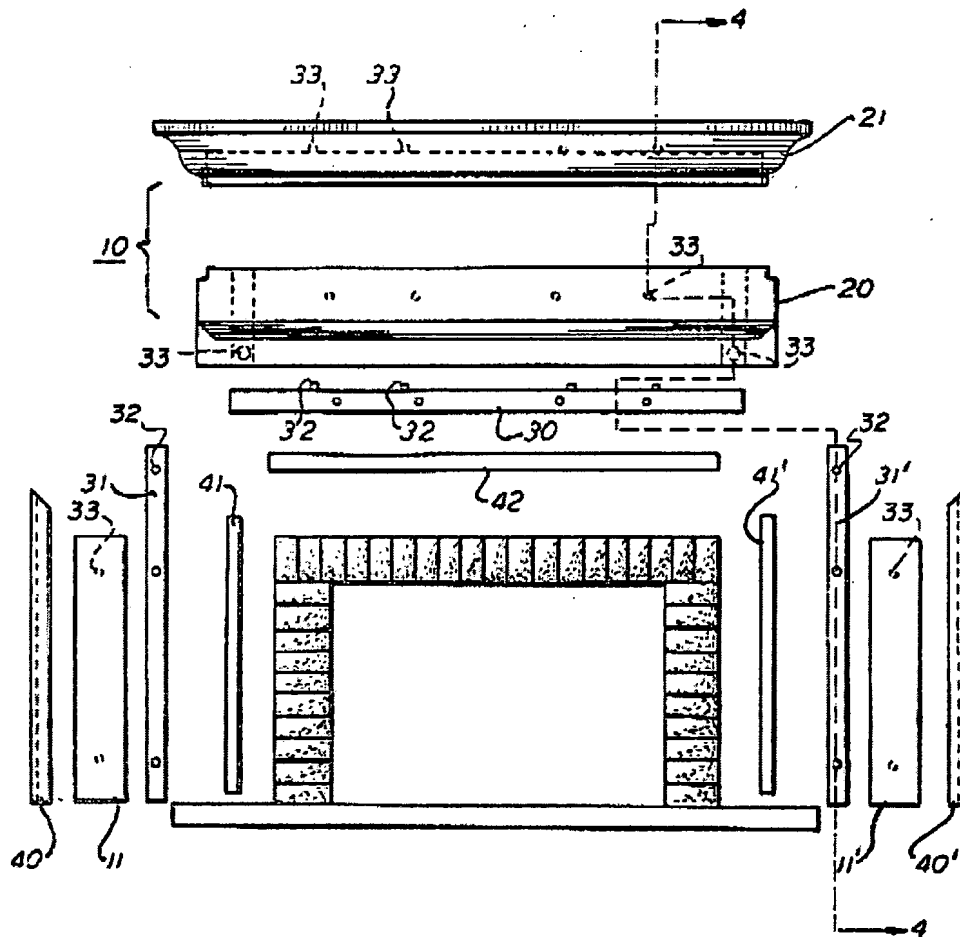
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- a. Pollock discloses a fireplace surround meeting all the limitations of claim 1 as set forth above, including a top member composed of two members with first ends facing one another.
- b. Pollock does not expressly disclose a retaining bracket for mounting the surround to an exterior portion of the fireplace or surrounding wall [claim 7]; or separate retaining members for separately supporting the first and second members [claim 8].
- c. Wright, et al. discloses a retaining bracket for mounting the surround to an exterior portion of the surrounding wall ("top support" 30, Fig. 1; "The assembleable mantelpiece may be installed ... by securing the top support 30 ... to the wall thereabout," column 2, lines 57-61) wherein the bracket supports the first and second members in fixed relation to one another ("male members" 32 on "top support" 30 supporting "face" 20, Fig. 1) [claim 7]; and separate retaining members for separately supporting the first and second members ("male members" 32, Fig. 1) [claim 8]. Mounting a retaining bracket as taught by Wright et al. ensures the first and second members of the surround are firmly secured in place.
- d. Pollock and Wright, et al. are analogous art because both are from the field of endeavor of fireplace surrounds.
- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the fireplace surround of Pollock to include the retaining member of Wright et al. in order to ensure safe and secure

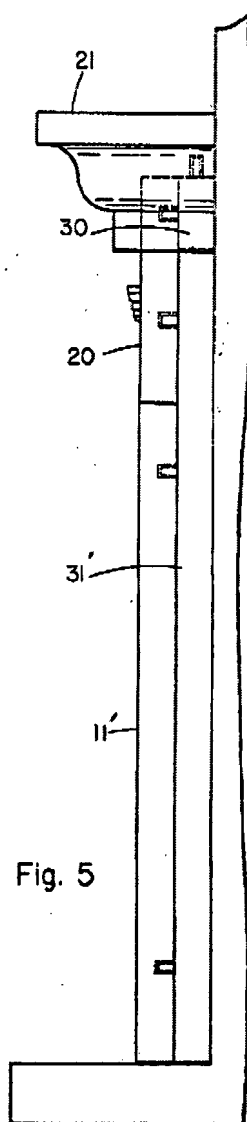
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attachment of the first and second members to the fireplace exterior or wall structure.

- f. The examiner further references Fig. 5 as an aid in determining how the pieces discussed above and shown in Fig. 1 connect together.

FIG. 1

Reproduced from U.S. Patent No. 4,254,596



Reproduced from U.S. Patent No. 4,254,596

40. Regarding claim 22, the combination renders the claimed method steps obvious since such would be the logical manner of using the combination.

41. Regarding claim 33:

- a. Pollock discloses a fireplace surround meeting all the limitations of claim 1 as set forth above.

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- b. Pollock does not expressly disclose a mantle shelf for mounting on top of the top member.
- c. Wright et al. discloses a mantel shelf for mounting on top of the top member ("top" 21 for mounting on "face" 20, Fig. 1 and Fig. 5). Mounting a mantel shelf on top of the top member as taught by Wright et al. provides the fireplace surround owner with a traditional mantel, giving the owner additional surface area for displaying Christmas cards, candle assortments, and other decorative frippery.
- d. Pollock and Wright, et al. are analogous art because both are from the field of endeavor of fireplace surrounds.
- e. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to modify the fireplace surround of Pollock by adding the traditional mantel piece of Wright et al. on top to further the sentimental and aesthetic appeal of applicant's fireplace surround.

Conclusion

42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Branon C. Painter whose telephone number is (571) 270-3110. The examiner can normally be reached on Mon-Fri 7:30AM-5:00PM, alternate Fridays off.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Victor Batson can be reached on (571) 272-6987. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Victor Batson
Supervisory Patent Examiner
Art Unit 3609

Branon Painter
05/24/2007